A1 cont.

substantially no adverse effect on said pigment particles after said liquid resin becomes hard.

REMARKS

I. REQUEST FOR REISSUE

As pointed out in applicants' accompanying reissue declaration, paragraphs 5-9, the patent claims can be read to be claiming more than patentees had a right to claim. For that reason, amended claims 1 and 15 as presented for reissue herein each contain an insertion in clause (3) that the coloring agent be disposed on the tape "beneath said hardenable liquid resin coating" Clearly, this limitation narrows the claims and removes any possibility that the claim can be read to cover the "excess" described in declaration paragraph 8. Support for this limitation is in the patent, e.g., at column 4, lines 17-18, and its original application claims 19 and 20, showing patentees objective intent to claim the subject matter of the reissue claims 1 and 15. Other than the amendments to claims 1 and 15, the original patent claims 1-33 are unchanged.

As discussed in paragraphs 8-12 of the reissue declaration, the error in possibly claiming more than patentees had a right to claim is believed to have been due to an interpretation of the scope of the claims of the patent at the time the application was filed and at the time it was issued as the subject patent. As the Federal Circuit indicated in *In re Wilder*, 222 USPQ 369, 371 (Fed.Cir. 1984), error in failing to

appreciate the full scope of the claimed invention is one of the most common sources of defects correctable by reissue.

Claims 34-42 have been entered herein for the purposes of requesting the declaration of an interference. However, none of claims 34-42 is broader in any significant respect than orignal patent claims 1-33.

Claim 34, the broadest of claims 34-42, was substantially copied from claim 1 of Scholz et al., U.S. Patent 5,342 291. However in copying that claim, care was taken not to enlarge its scope beyond that of the patent claims.

Comparing the "copied" claim 34 to applicants' patent claim 1, it can be seen that the added limitations "tape" and "fiberglass" are not broadening and exist in other patent claims, e.g., claim 19. The added limitations "and a bonding resin" and "bonding resin being cured" are more limiting at that point than any patent claim. Patent claims 9 and 12 expressly cover "pigment printing" which is defined in the specification at column 4, lines 22-29, to include a curable resin and solvent which are heated and cured to "fuse" the resin and pigment onto the fabric. Applicants have not added any claim broader in scope than the original claims and have maintained the scope of the added claims no broader than the patent claims as "narrowed" herein.

II. PENDING REQUEST FOR REEAMINATION OF APPLICANTS' PATENT

As pointed out in paragraph 13 of the accompanying declaration, there has been a third-party request to reexamine applicants' U.S. Patent 5,088.484 by John R. Schiffhauer, Registration No. 32,170, mailed September 29, 1994, alleging unpatentability in view of five references not of record in the file of the patent. A preliminary review of the request and the five refernces revealed nothing to merit reexamination. However, should reexamination be ordered, it is suggested that the reexamination proceedings be merged with this reissue application in accordance with the Office policy expressed in MPEP §2285, ¶2 on page 2200-57.

Applicants enclose herewith copies of the five references included with the reexamination request. Applicants also enclose copies of each of the 21 references made of record during the prosecution of applicants' patent are listed on the cover page thereof.

III. REQUEST FOR INTERFERENCE

Compliance With 37 CFR §1.607(a)

(a) Identification of the Patent

Applicants request that an interference be declared between applicants' above-identified reissue application and Scholz et al., U.S. Patent 5,342,291, issued August 30, 1994 (hereinafter "the Scholz patent"), a copy of which is enclosed herewith. Applicants hve in their claims 34-42 substantially

copied claims 1-3, 8, 10-11, 22, 28 and 17, respectively, of the Scholz patent.

The requested interference should be declared even though this is a reissue application. As sstated in MPEP §2301, first paragraph:

> The fact that an application is a reissue application does not preclude it from breing involved in an interference.

Since the Scholz patent did not issue until August 30, 1994, applicants have fully complied with the requirements of 35 USC §135(b) in claiming substantially the same subject matter directed to the same invention as that claimed in the Scholz patent prior to one year from the date that patent was granted. Indeed, applicants have been claiming substantially the same invention since their filing date of October 5,1990.

(b) Presentation of a Proposed Count

Applicants present in Appendix B attached hereto the "Proposed Count" for the requested interference. In compliance with 37 CFR §1.606, proposed Count 1 is broader than any claim in either this reissue application or the Scholz patent but is nevertheless directed to the same invention being claimed by both parties.

(c) Identification of Claims Corresponding to the Count

Applicants identify all of the Scholz claims 1-35 and applicants' claims 1-42 as corresponding to the proposed count and as being directed to the same patentable invention. While there are article claims and method/process claims in both

parties cases, the Examiners of both applications have treated all claims as directed to a single invention and did not require restriction. It is suggested that the same treatment be accorded here and that a single count be used for all claims.

(d) Application of the Terms of Applicants' Disclosure to the Copied Claims

In attached Appendix A, applicants illustrate the representative support in their disclosure for the limitations of their claim 34 substantially copied from claim 1 of the Scholz patent. There is, of course, additional support in applicants' application omitted for the sake of brevity.

(e) Applicants' Effective Filing Date

Applicants' present application, being a reissue application, has the identical specification and drawings as that originally filed in its application Serial No. 07/ 593,852, filed October 5, 1990. Accordingly, applicant's effective filing date is October 5, 1990.

(f) Scholz's Effective Filing Date

The Schpolz patent stems from U.S. Serial No. 751,725, filed August 29, 1991. Scholz has no claim for priority to any earlier-filed application.

Compliance With 37 CFR §1.608

Since applicants have the earlier filing date, there is no reason for them to establish a prima facie case of earlier priority under §1.608.

Reasons Why The Applicants' Claims And The Scholz Patent Are Directed to the Same Invention

Applicants used the term "and a bonding resin" instead of "binder." The Scholz patent describes "binders" at column 11, lines 37-64, and indicates that they can be selected from a wide variety of polymers and resins that bind the pigment particles to the substrate. Similarly, applicants point out at column 4, lines 17-29, that a resin is present with the ink pigment and "fuses" the pigment to the fabric when subjected to curing temperatures. Both parties' purposes are clearly the same.

Scholz claims that his pigment particles "do not migrate" and applicants claims the pigment particles "are stably retained." Applicants' specification at column 2, lines 41-48, makes it clear that the term "stably retained" refers to pigment in the presence of the hardenable liquid resin. Likewise, Scholz, at column 11, lines 20-26, indicates that the migration to be prevented would be caused by solubility in its curable resin. Applicants' claim limitation is broader but is clearly directed at the same problem. Migration of coloring agents is the major cause of pigment or color instability as can be seen in applicants' patent, column 1, lines 36-58.

Finally, Scholz claims that his pigment and binder are "relatively insoluble" in the curable resin, i.e., the hardenable liquid resin applied last over the printed tapes. Applicants' claims use the term "without any adverse effect" on the pigment, a broader term that includes Scholz's narrower term. It is clear from the Scholz patent, at column 11, lines 20-26, that the

relative insolubility of its pigment in binder is what saves it from being "adversely affected" by the liquid resin coated on the pigmented tape. The invention being claimed by both parties is directed at the very same problem to be solved in the exact same way.

The Requested Interference Should Be Declared

Applicants recognize the complexity in this case of a reexamination being requested of applicants' U.S. Patent 5,088,484. As previously suggested, if the reexamination request is not denied, the Examiner should act in accordance with MPEP §2285 and merge the reexamination into the present reissue proceeding in accordance with the Office policy.

Applicants respectfully request that the proposed interference be declared as promptly as possible. MPEP §2307 states as follows:

> Examiners should note that 37 CFR 1.607 requires that examination of an application in which applicant seeks an interference with a patent "shall be conducted with special dispatch." See MPEP §708.01 (emphasis added herein).

Applicants wish to point out that in their efforts to provoke the interference, several claims of the Scholz patent were substantially copied. Thus, some claim limitations are those that were examined and approved by the Examiner who allowed the Scholz patent. Should the present examination involve rejections of applicants' claims that would have been equally applicable against the Scholz claims, applicants respectfully note MPEP §2307.02, which requires the approval of the Group

Director for such a rejection. Applicants are presumptively the prior inventors of the claimed subject matter and only desire an interference to prove that they are the actual prior inventors. Their opportunity to do so should not be unduly delayed.

Please contact applicants' attorney, Francis A. Paintin, at 215-568 3100 if he can be of assistance in expediting this request.

Respectfully submitted,

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Date: Nov. 8, 1994

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